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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,076	01/10/2002	Osamu Nagai	P67506US0	1981
136	7590	06/07/2005	EXAMINER	
JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004			LE, HOA VAN	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/030,076

Applicant(s)

NAGAI ET AL.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

*Decision on Petition made on 27 May 2005*

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 23-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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This is in response to Decision on Petition made on 27 May 2005.

I. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 39-40 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Krasij et al (6,660,422).

Krasij et al disclose and teach a liquid rubber hardened gasket for a fuel cell battery comprising a liquid silicone rubber “14b” being hardened at about 100°C on an uneven and groove-like surface (upper end surfaces of “9”s and “8” in figure 5) of the fuel cell battery. Please see figure 5, col.4:42-50 and 5:4-7.

Krasij et al do not specify the product-by-process embodiment of “is integrally formed in the surface of...a groove portion”. Patentability of a product-by-process is based on a product in accordance with MPEP 2113. Applicant must show a processing step of making the product as

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claimed would provide a patentably distinct product. Applicants must show that a different product is made using their process.

Since Krasij et al are reasonably disclosed and taught the claimed embodiments, they are found to be rendered prima-facie obvious by Krasij et al.

II. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims (39-40 being broadest), 23, 27-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Sasaki et al (6,337,120).

Sasaki et al disclose and teach a gasket for use to seal a leakage in a cell battery. The gasket has two lips and coupling portion in between the lips to secure the electrode membrane unit having both sides with the electrodes and is made of a liquid rubber hardened. Please see figures 5 and 6 and their descriptions, col.2:4-7 and col.9:3. The functional language “adapted to...” has been considered. But it has reason to believe that they are inherent in the absence of convincing evidence to the contrary in accordance with the authority stated in In re Schreiber, 44 USPQ 1429. The preamble in the claims with respect to “for a fuel cell...” has no value in the above applied statutory.

Since Sasaki et al are reasonably disclosed and taught the above claimed embodiments, they are found to be anticipated by Sasaki et al.

III. Claims 24-26, 29-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al (6,337,120).

Sasaki et al disclose and teach a gasket for use to seal a leakage in a cell battery. The gasket has two lips and coupling portion in between the lips to secure the electrode membrane unit having both sides with the electrodes and is made of a liquid rubber hardened. Please see figures 5 and 6 and their descriptions, col.2:4-7 and col.9:3. The process for making the gasket is at figures 1, 2, 4, 5, 6, 7 and 8 and their descriptions, col.6:20-28, 42-43, 7:24-30, 8:53-58. The functional language “adapted to...” and “that is secure...” have been considered. But it has reason to believe that they are inherent in the absence of convincing evidence to the contrary in accordance with the authority stated in *In re Schreiber*, 44 USPQ 1429.

Sasaki et al do not specify chevron and trapezoidal shape in claims 24-25, 29, 31-32 and 37. However, Sasaki et al at figures 5, 6, 7 and 8 (as later broadly connected the separate embodiments in the specification and amended by applicant) show the obvious shapes to those of the claims. No unusual or unexpected result is on the record for the obviously claimed shapes.

Sasaki et al do not specify that the sealing shapes are off the centers of the bases in claims 26, 33 and 36. However, Sasaki et al at figures 8, 9 and 10 in view of figures 5 and 6 (as later broadly connected the separate embodiments in the specification and amended by applicant) show the obvious shapes to those of the claims. No unusual or unexpected result is on the record for the obviously claimed shapes.

Sasaki et al do not specify the all of steps of the method for forming the gasket as those in claims (35 broadest), 30, 34 and 38 as later broadly connected the separate embodiments in the

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specification and amended by applicant. However, Sasaki et al use the same or about the same molding apparatus, molding shapes and molding liquid rubber hardeners and general processing steps. Please the instant figures 1, 2, 3, 4, 5, 6, 7, 8, 10, 11 and 12 and those in Sasaki et al at figures 1, 2, 3, 4, 5, 6, 7, 8, 9 and 10. Accordingly, it has reason to believe that the same or about the same claimed steps have been done or could be done in Sasaki to obtain the same or about the same gaskets. There is no evidence on the record that the claimed steps are unusual or unexpected result those being done in Sasaki et al for obtained the same or about the same gasket.

Since Sasaki et al are reasonably disclosed, taught and suggested the claimed embodiments, they are found to be rendered prima facie obvious by Sasaki et al in the absence of unusual or unexpected result for the record in order to overcome the applied reference.

IV. Claims (30-40 being broadest, 23 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid et al (6,080,503).

Schmid et al disclose and teach a gasket for use to seal a leakage in a cell battery. The gasket has two lips and coupling portion in between the lips to secure the electrode membrane unit having both sides with the electrodes. Please see figures 1a and 5a and their descriptions, col.2:23-27, 6:45-46 and 8:42-49. The functional language “that is secure...” and “adapted to...” has been considered. But it has reason to believe that they are inherent in the absence of convincing evidence to the contrary in accordance with the authority stated in *In re Schreiber*, 44 USPQ 1429. The product-by-process language “made of a liquid rubber hardened” has no value

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since a the patentability is on the product in accordance with MPEP 2113 until applicant could be able to show a convincing evidence that the claimed processing steps would provide a patentably distinct product.

Schmid et al do not specify a lip base having a rectangular shape as claimed 23 and 27. However, Schmid et al base having a plat surface that would sufficiently prevent a leakage. There is no evidence on the record that the claimed rectangular shape would provide unusual or unexpected result over the plate surface as that in Schmid et al.

Since Schmid et al are reasonably disclosed, taught and the above claimed embodiments, they are found to be rendered prima facie obvious by Schmid et al.

V. Claims (30-40 being broadest, 23 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid et al (6,080,503) considered in view of Sasaki et al (6,337,120) or Krasij et al (6,660,422).

Schmid et al disclose and teach a gasket for use to seal a leakage in a cell battery. The gasket has two lips and coupling portion in between the lips to secure the electrode membrane unit having both sides with the electrodes. Please see figures 1a and 5a and their descriptions, col.2:23-27, 6:45-46 and 8:42-49. The functional language “that is secure...” and “adapted to...” has been considered. But it has reason to believe that they are inherent in the absence of convincing evidence to the contrary in accordance with the authority stated in In re Schreiber, 44 USPQ 1429.

The product-by-process language “made of a liquid rubber hardened” has no value

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since a the patentability is on the product in accordance with MPEP 2113 until applicant could be able to show a convincing evidence that the claimed processing steps would provide a patentably distinct product. However, each of Sasaki et al at at least col.9:3 or Krasij et al (6,660,422) at least col.5:4-7 to show the known use and made a gasket from a liquid rubber hardener for the advantage of obtaining a sufficient sealant.

Schmid et al do not specify a lip base having a rectangular shape as claimed 23 and 27. However, Schmid et al base having a plat surface that would sufficiently prevent a leakage. There is no evidence on the record that the claimed rectangular shape would provide unusual or unexpected result over the plate surface as that in Schmid et al.

Since the above references are all related to gaskets, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite the known use and made a gasket from a liquid hardener for a reasonable expectation of obtaining a sufficient sealant as disclosed, taught and suggested in Sasaki et al or Krasij et al.

VI. Claims (30-40 being broadest, 23 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida et al (6,316,139).

Uchida et al disclose and teach a gasket for use to seal a leakage in a cell battery. The gasket has two lips and coupling portion in between the lips to secure the electrode membrane unit having both sides with the electrodes. Please see figures 1A and C and their descriptions, col.2:29-30 and 4:49-51. The functional language “that is secure...” and “adapted to...” has been considered. But it has reason to believe that they are inherent in the absence of convincing



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evidence to the contrary in accordance with the authority stated in *In re Schreiber*, 44 USPQ 1429. The product-by-process language “made of a liquid rubber hardened” has no value since the patentability is on the product in accordance with MPEP 2113 until applicant could be able to show a convincing evidence that the claimed processing steps would provide a patentably distinct product.

Uchida et al do not specify a lip base having a rectangular shape as claimed 23 and 27. However, Uchida et al base has a flat surface that would sufficiently prevent a leakage. There is no evidence on the record that the claimed rectangular shape would provide unusual or unexpected result over the flat surface as that in Uchida et al.

Since Uchida et al are reasonably disclosed, taught and the above claimed embodiments, they are found to be rendered *prima facie* obvious by Uchida et al.

VI. Claims (30-40 being broadest, 23 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida et al (6,316,139) considered in view of Sasaki et al (6,337,120) or Krasij et al (6,660,422).

Uchida et al disclose and teach a gasket for use to seal a leakage in a cell battery. The gasket has two lips and coupling portion in between the lips to secure the electrode membrane unit having both sides with the electrodes. Please see figures 1A and C and their descriptions, col.2:29-30 and 4:49-51. The functional language “that is secure...” and “adapted to...” has been considered. But it has reason to believe that they are inherent in the absence of convincing evidence to the contrary in accordance with the authority stated in *In re Schreiber*, 44 USPQ 1429.

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However, each of Sasaki et al at at least col.9:3 or Krasij et al (6,660,422) at least col.5:4-7 to show the known use and made a gasket from a liquid rubber hardener for the advantage of obtaining a sufficient sealant.

Uchida et al do not specify a lip base having a rectangular shape as claimed 23 and 27. However, Uchida et al base has a flat surface that would sufficiently prevent a leakage. There is no evidence on the record that the claimed rectangular shape would provide unusual or unexpected result over the plate surface as that in Uchida et al.

Since the above references are all related to gaskets, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite the known use and made a gasket from a liquid hardener for a reasonable expectation of obtaining a sufficient sealant as disclosed, taught and suggested in Sasaki et al or Krasij et al.

VIII. Applicants arguments with respect to the applied prior art submission on 27 July 2004 have been considered. However, in view of the amendment, this Office action uses different rejections and references.

IX. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

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Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le  
Primary Examiner  
Art Unit 1752

HVL  
03 June 2005

HOA VAN LE  
PRIMARY EXAMINER  
*Hoa Van Le*